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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/558,519

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Peter V. Boesen M.D.

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

09/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/558,519	Applicant(s) BOESEN M.D., PETER V.	
	Examiner Natalie A. Pass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-89, 92-94, 98-100, 102, 103, 105, 108 and 110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-89, 92-94, 98-100, 102-103, 105, 108, 110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Notice to Applicant

1. This communication is in response to the amendment filed 1 May 2008. Claims 84-86, 88-89, 92-94, and 98 have been amended. Claims 1-83, 90-91, 95-97, 101, 104, 106-107, 109 and 111 have been previously cancelled. Claims 84-89, 92-94, 98-100, 102-103, 105, 108, 110 remain pending.

Claim Rejections - 35 USC § 112

2. The rejections of claims 85-86, 88-89, 92-94, 98 under 35 U.S.C. 112, second paragraph is hereby withdrawn due to the amendment filed 1 May 2008.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in 3section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 84, 88-89, 94, 98-100, 102-103, 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al., U.S. Patent Number 6, 393, 404 in view of Dorne, U.S. Patent Number 5, 325, 293 and Goltra, U.S. Patent Number 5, 823, 949 for substantially the same reasons given in the previous Office Action (paper number 20071025). Further reasons appear hereinbelow.

(A) Claim 84 has been amended to include the recitation of “to thereby provide a record of the procedure performed, a record of each diagnosis supporting the procedure

performed, and a user defined ranking of each diagnosis supporting the procedure performed,” in lines 14-16.

As per these new limitations, Waters, Dorne and Goltra teach a method as analyzed and discussed in the previous Office Action (paper number 20071025) further comprising documenting the patient encounter by storing the rank ordering of the selection of the plurality of diagnosis codes linked to the selection of the patient “medical finding” (reads on “procedure”) code of the procedure performed (Goltra; column 6, lines 1-8) to thereby provide a record of the “medical finding” (reads on “procedure performed”) (Goltra; column 3, lines 22-28, 39-50), a record of each diagnosis supporting the “medical finding” (reads on “procedure performed”) (Goltra; column 4, lines 57-60), and a user defined ranking of each diagnosis supporting the procedure performed (Goltra; column 2, lines 52-55, column 4, line 57 to column 5, line 7, column 6, lines 1-8).

The remainder of claim 84 is rejected for the same reasons given in the prior Office Action (paper number 20071025, section 6, pages 3-6), and incorporated herein.

The motivations for combining the respective teachings of Waters, Dorne and Goltra are as given in the rejection of claim 84 in the prior Office Action (paper number 20071025) and incorporated herein.

(B) As per the amendments to claims 88-89, 94, 98, these appear to have been made merely to correct minor typographical or grammatical errors or to overcome rejections under 35 U.S.C. 112, second paragraph. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as

originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action. As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20071025, section 6, pages 6-8), and incorporated herein.

(C) Claims 99-100, 102-103, 110 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20071025, section 6, page 8), and incorporated herein.

5. Claims 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al., U.S. Patent Number 6, 393, 404, Dorne, U.S. Patent Number 5, 325, 293 and Goltra, U.S. Patent Number 5, 823, 949, as applied to claim 84 above, and further in view of Lavin et al, Pat. No. 5,772,585 for substantially the same reasons given in the previous Office Action (paper number 20071025). Further reasons appear hereinbelow.

(A) As per the amendments to claims 85-86, these appear to have been made merely to correct minor typographical or grammatical errors or to overcome rejections under 35 U.S.C. 112, second paragraph. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action. As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20071025, section 7, pages 8-10), and incorporated herein.

(B) Claim 87 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 20071025, section 7, pages 8-10), and incorporated herein.

6. Claims 92-93, 105, 108, are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al., U.S. Patent Number 6, 393, 404 in view of Goltra, U.S. Patent Number 5, 823, 949 for substantially the same reasons given in the previous Office Action (paper number 20071025). Further reasons appear hereinbelow..

(A) Claim 92 has been amended to include the recitation of

- ♦ “provide a record of the procedure performed, a record of each diagnosis supporting the procedure performed, and a user defined ranking of each diagnosis supporting the procedure performed” in lines 13-15.

As per these new limitations, Waters and Goltra teach a method as analyzed and discussed in the previous Office Action (paper number 20071025) further comprising linking the plurality of diagnosis codes in a user defined rank order to the patient procedure code such that a defined relationship between the patient procedure code and the plurality of diagnosis codes is maintained to thereby provide a record of the “medical finding” (reads on “procedure performed”) (Goltra; column 3, lines 22-28, 39-50), a record of each diagnosis supporting the “medical finding” (reads on “procedure performed”) (Goltra; column 4, lines 57-60), and a user defined ranking of each diagnosis supporting the procedure performed (Goltra; column 2, lines 52-55, column 4, line 57 to column 5, line 7, column 6, lines 1-8) to

provide a record of the patient encounter (Goltra; column 2, lines 25-27, column 4, line 58 to column 5, line 31, column 6, lines 1-10)

The remainder of claim 92 is rejected for the same reasons given in the prior Office Action (paper number 20071025, section 8, pages 10-11), and incorporated herein.

The motivations for combining the respective teachings of Waters and Goltra are as given in the rejection of claim 92 in the prior Office Action (paper number 20071025) and incorporated herein.

(B) As per the amendments to claim 93, these appear to have been made merely to correct minor typographical or grammatical errors or to overcome rejections under 35 U.S.C. 112, second paragraph. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action. As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20071025, section 8, page 11), and incorporated herein.

(C) Claims 105, 108, have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20071025, section 8, pages 11-12), and incorporated herein.

Response to Arguments

7. Applicant's arguments filed 1 May 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 1 May 2008.

At pages 7-14 of the 1 May 2008 response, Applicant argues that the features and the newly added features in the 1 May 2008 amendment are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the features newly added in the 1 May 2008 amendment, have been fully addressed by the Examiner as being obvious in view of the teachings of Waters, Dorne, Goltra, and Lavin, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20071025), and incorporated herein. In particular, Examiner notes that the features of “linking the selection of the patient procedure code to the selection of the plurality of diagnosis codes” and “providing a user interface adapted for ranking the plurality of diagnosis codes linked with the patient procedure code in a user defined rank order after receiving the selection of the plurality of diagnosis codes” to better document a patient encounter are taught by the combined applied references; see, for example, (Goltra; column 2, lines 9-27, column 3, lines 39-41, column 4, line 57 to column 5, line 31, column 6, lines 6-10). Examiner interprets Goltra's teachings of “[w]hen the intelligent prompting feature is selected, the computerized medical system takes each ‘medical finding’ [reads on “procedure”] entered into the protocol and builds an internal list of possible diagnoses. The list of possible diagnoses is formed by using the point values

assigned to each medical finding for each diagnosis stored in the knowledge base file 22. When all of the medical findings have been added together for each diagnosis, the diagnoses are ranked in descending point total ... [...] ... it may be possible for a healthcare professional to change the system ...” (emphasis added) (Goltra; column 4, line 57 to column 5, line 4); together with Goltra’s teachings of “configurable by the healthcare professional so as to provide specific help in determining diagnoses” (emphasis added) (Goltra; column 2, lines 25-27); together with Goltra’s teachings of “each medical finding also contains a code which indicates which category within the database file 20 the medical finding is associated [reads on “linked”] with” (emphasis added) (Goltra; column 3, lines 39-41) and Goltra’s teachings of “the medical findings used in the detailed descriptions of the diagnoses are all coded, with their respective internal numbers. In addition, over 400,000 links are provided ...;” (Goltra; column 4, lines 13-17) and Goltra’s teachings of “the healthcare professional may enter one or more medical findings into the computerized medical system into a clinical protocol. Clinical protocols are a structured combination of coded medical phases selected from a structured medical database of coded phases and is presented in the order of appearance desired by the healthcare professional [reads on “a user defined rank order”]” (Goltra; column 4, lines 35-41); and Goltra’s teachings of “[t]he medical system will then generate a list of most likely diagnoses based upon the point values assigned to the entered medical findings ... ” (Goltra; column 6, lines 6-10) in a “computer based medical system which enhances the diagnostic, management and documentation capabilities of a healthcare provider” (Goltra; column 2, lines 34-38) to teach a form of “linking the selection of the patient procedure code to the selection of the plurality of

diagnosis codes” and “providing a user interface adapted for ranking the plurality of diagnosis codes linked with the patient procedure code in a user defined rank order after receiving the selection of the plurality of diagnosis codes” to better document a patient encounter (as recited in claims 84, 92, 98, and 105).

At the paragraph bridging pages 7-8 and in paragraph 1 of page 8 of the 1 May 2008 response Applicant asserts that Applicant’s “claimed invention is directed towards a doctor-defined linkage ... [...] ...” and that “merely recording the procedure codes and diagnosis codes does not convey which of the diagnosis codes were the reason that a care provider performed a particular procedure ... [nor] ... which of the diagnosis codes were the most important to the care provider in the decision to perform a particular procedure” however Examiner respectfully notes that these are not claimed limitations.

At page 9, paragraph 1 of the 1 May 2008 response, Applicant argues that the Waters reference does not teach the limitations discussed in the preceding paragraphs. Examiner respectfully notes that it was the Goltra reference, and not the Waters reference, that was applied to teach these argued limitations.

At page 9, paragraph 2 of the 1 May 2008 response, Applicant argues that the Waters reference “teaches away from the claimed methodology” because Waters selects codes for usage based on optimized billing and not to document an encounter. Examiner respectfully disagrees. Examiner notes that Waters teaches a system that includes providing “a list of ordered procedures listing medical procedures for a specific medical encounter” (Waters; Abstract,

column 2, lines 47-48) and which “optimize[s] the ordered procedures for billing and patient encounter recording purposes” (Waters; column 2, lines 26-28). Therefore Examiner asserts that the Waters reference does not “teach away,” as asserted by Applicant.

At pages 9-11 of the 1 May 2008 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

At pages 10-11 of the 1 May 2008 response, Applicant argues that the Goltra reference does not teach the limitations argued in the preceding paragraphs. Examiner respectfully disagrees, and notes that these limitations have been previously discussed in this Office Action.

At pages 12-13 of the 1 May 2008 response, Applicant argues that none of the applied references teach the limitations of amended claim 92, and of claim 105. Examiner respectfully disagrees, and notes that these limitations have been previously discussed in this Office Action.

At pages 13-14 of the 1 May 2008 response Applicant argues that the applied references fail to teach “using the user interface to reorder the plurality of diagnosis codes.” Examiner respectfully disagrees. Examiner interprets Goltra’s teachings of “[t]he healthcare professional may enter one or more medical findings into the computerized medical system into a clinical protocol. Clinical protocols are a structured combination of coded medical phases selected from a structured medical database of coded phases and is presented in the order of appearance desired by the healthcare professional (emphasis added) (Goltra; column 4, lines 35-41) and “configurable by the healthcare professional so as to provide specific help in determining diagnoses” (Goltra; column 2, lines 25-27) and “[t]he medical system will then generate a list of most likely diagnoses based upon the point values assigned to the entered medical findings. A list of additional medical findings will then be displayed on the display screen” (Goltra; column 6, lines 6-10) and “computerized medical system takes each medical finding [reads on procedure] entered into the protocol and builds an internal list of possible diagnoses. The list of possible diagnoses is formed by using the point values assigned to each medical finding for each diagnosis stored in the knowledge base file 22. When all of the medical findings have been added together for each diagnosis, the diagnoses are ranked in descending point total. ... [...] ... It will be understood that while the computerized medical system may be set to a default value, it may be possible for a healthcare professional to change the system ... [...] ... depending on the desires of the healthcare professional” (Goltra; column 4, line 58 to column 5, line 31) to teach a form of “using the user interface to reorder the plurality of diagnosis codes.”

In response to Applicant's argument at the paragraph bridging pages 13-14 of the 1 May 2008 response that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Conclusion

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please label

"PROPOSED" or "DRAFT" on the front page of the

communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. A. P./
Examiner, Art Unit 3626
September 11, 2008

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3626